

REMARKS

After entry of the above amendment, claims 1-18 will be pending in this application. The amendment does not add any new matter. Accordingly, its entry is respectfully requested.

1. Rejection of claims 1-4 under 35 U.S.C. §112, 2nd paragraph

The Official Action states that claims 1-4 are rejected under 35 U.S.C. §112, 2nd paragraph as being indefinite.

RESPONSE

Applicant traverses this rejection. With regard to claim 1, applicant has amended claim 1 to render the antecedent basis rejection moot. With further regard to claim 1, applicant respectfully points out to the Examiner that the limitation "a third party purchasing said one or more reusable shipping structures with materials thereon from said second party at a second value y" is perfectly clear in view of the present specification. However, to render this claim rejection moot, applicant has introduced an amendment to claim 1 to clarify this point.

Accordingly, applicants respectfully request that the Examiner reconsider and withdraw this rejection.

2. Rejection of claims 1-8 and 10-18 under 35 U.S.C. §102(e)

The Official Action states that claims 1-8 and 10-18 are rejected under 35 U.S.C. §102(e) as being anticipated by Richards et al. (US Published Application No. 2003/0083920).

As the basis of this rejection, the Official Action states the following, in relevant part:

Richards discloses a method of administering the cyclic use and movement of one or more reusable shipping structures comprising: providing one or more empty reusable shipping structures to a second party at a first value x; said second party placing materials on said one or more reusable shipping structures; and a third party purchasing said one or more reusable shipping structures with materials thereon from said second party at a second value y; wherein said second value y is less than said first value x.

Response

Applicant respectfully traverses this rejection. The Richards et al. reference does not teach each and every element of the presently claimed invention as alleged by the Examiner and, thus, cannot anticipate the presently pending claims.

The test for anticipation is whether each and every element as set forth is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP §2131. The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP § 2131. The elements must also be arranged as required by the claim. *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

The Scope of the Presently Pending Claims

The presently pending claims are directed to a method of administering cyclic use and movement of one or more reusable shipping structures comprising:

- a. a first party providing one or more empty reusable shipping structures to a second party at a first value x ;
- b. said second party placing materials on said one or more reusable shipping structures; and
- c. a third party purchasing said one or more reusable shipping structures from said second party at a second value y , wherein the shipping structures have materials thereon;

wherein said second value y is less than said first value x .

The Teachings of the Cited Art

In contrast, the Richards et al. reference teaches a method for tracking shipping platforms that have been stencilled with a specific design by using a website. The Richards et al. reference does not teach the presently claimed process, specifically step c. of the presently claimed process, wherein a “third party” purchases one or more reusable shipping structures from a “second party” at a value y wherein the shipping structures have materials thereon and wherein the value y is less than the value x .

The Examiner has alleged that all the limitations of claim 1 are taught by Richards et al. in the Abstract, Figure 1 and Paragraphs 19, 31-32 and 34-35. However, Richards et al. fail to recite the presently claimed process. Richards et al. discloses a “platform

manufacturer”, which is similar to the “first party” recited in the presently pending claims, in paragraph [0024]. Richards et al. also discloses a “shipper” in paragraph [0025], which is similar to the “second party” recited in the presently pending claims. The shipper uses a stencilled shipping platform to ship products to “direct recipients”. These “direct recipients” are similar to the “third party” recited in the presently pending claims.

In contrast to the presently claimed invention, however, Richards et al. discloses that the shipping structures are not themselves sold by the shipper / second party. Instead, Richards et al. discloses that the product on the shipping structure is sold by the shipper / second party. See [0025]. After the shipping structures are used by the “direct recipient” (i.e., “third party”), the shipping structures progress to an “end recipient” such as a recycler or scrap dealer. No value of the shipping structure is disclosed by Richards et al. Thus, step c. of the presently claimed process wherein the shipping structures themselves are sold at a certain “value y” is clearly not taught by Richards et al. Further, then, it is impossible for the Richards et al. reference to teach the additional limitation “wherein the second value y is less than said first value x”.

As such, because Richards et al. does not disclose a process wherein the shipping structure itself is purchased by the direct recipient / third party from the shipper / second party, it does not teach each and every element of presently pending claim 1, as required by *Verdegaal Bros. v. Union Oil Co. of California*, supra. As such, the Examiner has not established a *prima facie* case of anticipation against the presently pending claims 1-8 and 10-18.

Accordingly, applicant respectfully requests that the Examiner reconsider and

withdraw this rejection.

3. Rejection of claim 9 under 35 U.S.C. §103(a)

The Official Action states that claim 9 is rejected under 35 U.S.C. §103(a) as being unpatentable over the teachings of Richards et al. in view of the Efficient Foodservice Response (EFR) reference.

Response

Applicants respectfully traverse this rejection. The Examiner has not shown a *prima facie* case of obviousness with respect to the presently rejected claims.

To establish a *prima facie* case of obviousness, the PTO must satisfy three requirements. First, as the U.S. Supreme Court very recently held in *KSR International Co. v. Teleflex Inc. et al.*, Slip Opinion No. 04–1350, 550 U. S. ____ (April 30, 2007), “a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions. ...it [may] be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. ...it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does... because inventions in most, if not all, instances rely upon building blocks

long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.” (*KSR, supra*, slip opinion at 13-15.) Second, the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *Amgen Inc. v. Chugai Pharm. Co.*, 18 USPQ2d 1016, 1023 (Fed. Cir. 1991). Lastly, the prior art references must teach or suggest all the limitations of the claims. *In re Wilson*, 165 USPQ 494, 496 (C.C.P.A. 1970).

A *prima facie* case of obviousness must also include a showing of the reasons why it would have been obvious to modify the references to produce the present invention. See *Ex parte Clapp*, 277 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). The Examiner bears the initial burden to provide some convincing line of reasoning as to why the ordinary skilled artisan would have found the claimed invention to have been obvious in light of the reference teachings. *Id.* at 974.

Further, appellant notes that a *prima facie* case of obviousness can be rebutted if she can show “that the art in any material respect taught away” from the claimed invention. *In re Geisler*, 43 USPQ2d 1362, 1365 (Fed. Cir. 1997).

As discussed above in section 2, the Richards et al. reference does not teach or suggest every limitation of the presently pending claims. As such, the Examiner has failed to establish a *prima facie* case of obviousness with the teachings of the Richards et al. reference.

The EFR reference fails to remedy the deficient teachings of the Richards et al.

reference. The EFR reference is a report which discloses the results of an Efficient Foodservice Response Executive Committee's study which identifies possible improvements in the management of shipping platforms. However, the EFR reference fails to teach a process wherein a "third party" such as a direct recipient of that has received goods on a shipping platform purchases one or more reusable shipping structures from a "second party" at a value y , wherein the value y is less than the value x .

Thus, neither of the cited references, alone or in combination, teach or suggest every limitation of the presently pending claims as required by *In re Wilson*.

Accordingly, applicant respectfully requests that the Examiner reconsider and withdraw this rejection.

CONCLUSION

Based upon the above amendments and remarks, the presently claimed subject matter is believed to be novel and patentably distinguishable over the prior art of record. The Examiner is therefore respectfully requested to reconsider and withdraw all rejections and allow all pending claims in this application. Favorable action with an early allowance of the claims pending in this application is earnestly solicited.

The Examiner is welcomed to telephone the undersigned attorney if she has any questions or comments.

Respectfully submitted,

THE NATH LAW GROUP

A handwritten signature in black ink, appearing to read 'Gary M. Nath', is written over a horizontal line.

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